(4) Remarks

Reconsideration and allowance of claims 1-3, all of the claims remaining n in this application, are respectfully requested in view of the following remarks.

The amendments are properly presented at this time because they are responsive to the Office Action by clarifying points previously discussed and to the new art cited. Accordingly, entry at this time is believed in order.

Support for the amendments is found in the original disclosure, in particular paragraphs 0015-0018 and 0034 of the published text.

I. Title

Applicants have amended the title as suggested in view of the cancellation of the claims to the kit, which applicants intend to refile in a divisional application.

II. Claim Rejections – 35 USC §112

Applicants have amended claims 1-3 consistent with the disclosure and the examiner's comments and to provide a more clear statement of the invention and its distinctions from the prior art.

III. Claim Rejections – 35 USC §103

It will be recalled that the invention relates to a process for imparting a wood grain and coloration to a textured substrate. It is an expressed objective of the invention to develop a proper color foundation for the system over any color door skin. The specification notes that some door skins are green, white, gray, etc., but the invention is able to control the final color by painting the door to establish the background base color over any color embossed substrate. The first and second coats provide complimentary coloration, with the net effect being a selected wood coloration. The invention achieves color reproducibility that does not rely on the supplied color of the door, itself; to

establish the natural color of the wood species selected or desired by the user (oak, pine, cherry, etc.).

The process utilizes two complementarily pigmented coatings. Both are water based and easy to use, but are together highly durable.

The first coat of the invention is opaque and the second is lightly pigmented to compliment that of the base and provide a combined color different from either and the color of wood. The examiner's attention is again directed to the samples provided during the interview. The two coats are necessary together to define a wood coloration. The base coat is a specific opaque color and is uniform over any substrate material variations. The colors work together and are easily applied – both initially and in the case a repair is needed.

The use of complimentary differently colored coats – makes it easy for a consumer or commercial user to uniformly finish different construction materials. The door and window can be of different materials – some parts wood, some plastic and some metal and all of different color, but the worker will still get good results. It also makes repair a simple process. The combined use of a base coat with a graining coat as provided by the invention also provides a brilliance and depth of natural wood simulation that is distinctly different than achieved by prior art methods. These are all major distinctions from and advantages over the prior art. Applicants have amended claim 1 to eliminate any confusion that the base coat is a conventional stain. Indeed, in paragraph 0036 of the published specification applicants make the distinction over such materials which tend to be translucent, not opaque. The use of the opaque coloration in this step has several advantages as noted, especially when used with a complimentary top coat as the finish coat.

The two colors for the two coats of the inventive process are necessary for the process and nothing like this is suggested by the prior art. The second or graining coat changes the color provided the base coat and highlights the ticks, without simply filling

them in with a dark, opaque color. As with real wood, the ticks retain a background hue and have a wood-like look. The overall color is that of the desired wood for which the pigments of the two coats were selected to achieve.

The Pittman, *et al.*, reference certainly does not show a second coat as claimed in combination with a first coat to achieve the objectives of this invention, as now more clearly set out in the claims. The references together – Pittman, *et al.*, and Plowman, *et al.* – fully fail to provide any teaching or suggestion to combine portions of their teachings into a single process wherein two coatings provide complementary colors for graining wood while providing a natural-appearing wood color simulation having high durability without the use of a special, additional, top coat.

The coating of Pittman, *et al.*, is different in composition and purpose from what is claimed here. Thus, it would not be obvious for the person of ordinary skill in the art to optimize it by using a low application rate to effect the claimed purposes of *spreading the graining coat to color at least a majority of texture recesses in the substrate, while retaining a coating of the darkening graining coat on the textured surface, which together with the base coat color, provides a natural coloration of a selected wood type.*

The Plowman, *et al.*, reference does not supply the information missing from Pittman, *et al.*, to make the presently claimed invention obvious to the person skilled in the art. At column 1, lines 49-53, the reference states the problem they were addressing – one different from either Pittman, *et al.*, or the present invention:

> Thus it becomes difficult, if not impossible, to achieve the desired end effect of leaving accent color only in the embossed low areas of the product, and not on the surface, if the reverse wipe technique is employed.

Clearly, they do not want to provide a wood-like coloration by leaving pigmented second coat on the surface of the substrate. Their stated concern is "leaving accent color only in the embossed low areas of the product, and not on the surface..."

They note that simply wiping with a firm roller moving reverse to the direction of the piece does not solve the problem. They reject this approach because the severe wiping

action tends to mark or score the product surface. Instead, they coat the surface in both valleys and highest ridges and then remove the coating from the ridges.

Pittman, *et al.*, state that in their process "pressure contact is effected between the panel surface and a rotating resiliently deformable roll surface whereby said roll surface deforms under the influence of the contact pressures and contacts at least the higher ones of the ridges and effects removal of pigmented or accent material from the contacted portions of the panel surface". Following removal of this contrast coat from the surface, they provide "a clear protective overlay coating", which is applied after completion of the above steps. The need for a final protective coating is fully consistent with their stated concern "leaving accent color only in the embossed low areas of the product, and not on the surface..."

Pittman, *et al.*, require three coats, talk only of contrasting colors, do not talk of wood coloration and, in their preferred mode, add a layer of paper and include an embossing step. The present invention requires only two coats, which are complimentary in coloration and provide the desired coloration and texture of a selected type of wood. The invention is simpler, different in objective, different in process manipulations and different in result.

The Office Action selects out of this teaching a subjective interpretation, not clearly expressed as even a concept in the reference itself, that some pigment remains on the top surfaces of the coated substrate. The wording selected from the patent does not provide a teaching of the prior art as would make the claimed invention obvious from the teachings of the references.

In applicants' claimed process, the graining coat is selected to be used with a specific color base coat to simulate wood coloration and graining and provide a durable finish. This is not rendered obvious by the teachings of Plowman, *et al.*, taken in any combination with Pittman, *et al.*

To establish *prima facie* obviousness, three basic criteria must be met. According to MPEP §2142, they are: (1) there must be some suggestion or motivation (2) there must be a reasonable expectation of success, and (3) the prior art must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Applicants note that the first criteria is not met because there are no specific reasons are given in the references themselves or from any presentation of logic as to why someone skilled in the art would be motivated to make the modifications necessary to meet the terms of the claims. There is no reasoning given by the examiner on how the person skilled in the art might be motivated from the deficient teachings of the reference to modify those teachings for applicants' new purpose and new concentrations. There is no logical reason apparent from either the reference or the Office Action as to why the person skilled in the art would put aside the teachings of the reference and adapt those teachings to achieve a purpose not taught other than by applicants' own description.

The Office Action also fails to meet the second criteria. There must be a reasonable expectation of success. The rejection set out by the Office Action calls for changing the teachings of the references to effect their combination; however, with no teachings of an overall similar objective, the skilled worker would not know how to make it work with a reasonable expectation of success to meet applicants' purposes. There is no reasoning given in the Office Action as to why the person skilled in the art would adapt the teachings of Pittman to incorporate the "concept" of Plowman, *et al.*, with any reasonable expectation that the combined process would work for applicants' disclosed purpose.

Significantly, the Office Action fails to fully address point (3) – the prior art must teach or suggest all the claim limitations. Pittman fails to teach the use of a pigmented paint coat for a step #2 coating, which is complimentary with the step #1 coat to provide an intended wood coloration. The step # 2 coating of applicant is not only a graining coat,

it is a complimentary and finish coat. The purpose disclosed by Plowman, *et al.*, is very different than applicants' purpose, and there is no sound reason of record why one skilled in the art would attempt to use part of one process with part of another, with *no guidelines as to optimization* for a purpose identified by either. Applicants have provided a process having a different utility from the references and carry it out in a different manner than either of the references. This amounts to invention – not optimization. Looking at it another way, it is not obvious to optimize an unknown.

It is thus apparent that the prior art does not teach or suggest all the claim limitations. It does not teach applicants' type of coats, their complementary coloration or effects, or their concentrations, and it does not teach the effect attributed to the low concentration by applicants. Therefore, the person skilled in the art would not find optimization obvious.

Claim 3 has been rejected under 35 USC §103 as defining an invention which is obvious from Pittman, *et al.*, in view of Porter. This rejection is respectfully traversed for the reasons above and because there is no reason or motivation for making the change seen from the references themselves. Indeed, even were the changes to be made in accord with the reference teachings for some other purpose, the modified process would not meet the terms of the present claims and would not render such obvious.

Again, applicants stress that their method for making a door appear like a natural wood door – in coloration and graining (and regardless of the substrate color or colors) – is not in any manner taught or suggested by the prior art. The combined use of a base coat with a graining coat – both coatings pigmented specifically to be complimentary in color effect – as provided by the invention, provides a brilliance and depth of natural wood simulation that is distinctly different than achieved by prior art methods.

The two colors are necessary for the process and nothing like this is suggested by the prior art. The second or graining coat changes the color provided the base coat and highlights the ticks, without simply filling them in with a dark, opaque color. As with real

wood, the ticks retain their background hue but and have a wood-like look. Even were one skilled in the art to use the Porter coating for weathering resistance, there would be no teaching or direction in the art to positively use the coating as a manner to adjust the color of a base coat to provide the coloration of wood while enabling graining without simply filling ticks with dark pigment.

The invention requires a conscious effort to select complimentary pigments and coating vehicles which when properly applied provides and truly wood like appearance, but is yet very durable and easily achieved. The prior art does not teach enough of the overall process to render it obvious to the person skilled in the art.

Applicants have made a significant contribution to the art of finishing doors and other objects to achieve a natural wood coloration with natural appearing graining. The process of the invention not only appears simple, it is simple – something a handyman or even a skilled cabinet shop owner will truly appreciate. The claims set forth the invention clearly and concisely in terms which distinguish from the prior art. Accordingly, allowance of all claims is believed in order and such action is earnestly solicited.

Respectfully submitted,

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